

## **REMARKS:**

Claims 1-28 are currently pending in the application. Claims 7-10, 16-19, and 25-28 stand objected to for informalities. Claims 1, 5, 11, and 20 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1, 3-11, 13-20, and 22-28 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,460,038 to Khan *et al.* ("*Khan*"). Claims 2, 12, and 21 stand rejected under 35 U.S.C. § 103(a) over *Khan* in view of U.S. Patent No. 5,931,900 to Notani *et al.* ("*Notani*").

By this Amendment, independent claims 1, 11, and 20 and dependent claims 5, 7-10, 16-19, and 25-28 have been amended to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent application of substantially the same scope of originally filed claims 1-28. No new matter has been added.

## **CLAIM OBJECTIONS:**

Claims 7-10, 16-19, and 25-28 stand objected to for informalities

Specifically, the Examiner asserts that claims 7-10, 16-19, and 25-28 "were amended to change a user (singular) to one or more buyers (possibly plural)" and the "terms appear to be used in an identical manner in the disclosures." (23 March 2006 Office Action, Page 4). The Applicants respectfully disagree.

Nonetheless, the Applicants have amended claims 7-10, 16-19, and 25-28 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the objection of these claims, as set forth in the Office Action. Particularly, the Applicants reserve the right to file additional claims in this

Application or through a continuation patent application of substantially the same scope of originally filed claims 7-10, 16-19, and 25-28.

**REJECTION UNDER 35 U.S.C. § 112:**

Claims 1, 5, 11, and 20 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Specifically, the Examiner asserts that the “claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” (23 March 2006 Office Action, Pages 4-5). The Applicants respectfully disagree.

Nonetheless, the Applicants have amended independent claims 1, 11, and 20 and dependent claim 5 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner’s position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent Application of substantially the same scope of originally filed claims 1, 5, 11, and 20.

The Applicants respectfully submit that amended independent claims 1, 11, and 20 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicants further submit that amended independent claims 1, 5, 11, and 20 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 1, 5, 11, and 20 under 35 U.S.C. § 112 be reconsidered and that claims 1, 5, 11, and 20 be allowed.

## REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1, 3-11, 13-20, and 22-28 stand rejected under 35 U.S.C. § 103(a) over *Khan* over the Examiner's Official Notice. Claims 2, 12, and 21 stand rejected under 35 U.S.C. § 103(a) over *Khan* in view of *Notani*.

Although the Applicants believe claims 1-28 are directed to patentable subject matter without amendment, the Applicants have amended independent claims 1, 11, and 20 and dependent claims 5, 7-10, 16-19, and 25-28 to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicants respectfully submit that *Khan*, *Notani*, or the Examiner's Official Notice, either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 1-28. Thus, the Applicants respectfully traverse the Examiners obvious rejection of claims 1-28 under 35 U.S.C. § 103(a) over the proposed combination of *Khan*, *Notani*, or the Examiner's Official Notice, either individually or in combination.

### **The Proposed *Khan*-Official-Notice Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

For example, with respect to amended independent claim 1, this claim recites:

***An electronic commerce system*** for facilitating an electronic commerce transaction, the electronic commerce system **comprising:**

***a global content directory for providing a plurality of buyers access to a distributed plurality of seller databases***, each seller database associated with a corresponding seller and ***distinct from other seller databases in the distributed plurality of seller databases***, the global content directory comprising:

***a directory structure comprising a plurality of product classes organized in a hierarchy***, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class;

***one or more pointers associated with each product class in the plurality of product classes, each pointer identifying the seller database in the distributed plurality of seller databases in which product data enabling a product transaction is stored for products***

**associated with the product class, the seller database identified by the pointer being associated with its corresponding seller and being distinct from the other seller databases in the distributed plurality of seller databases; and**

**a search interface operable to communicate a search query for product data to the one or more seller databases identified by the one or more pointers associated with the selected product class,** each seller database associated with its corresponding seller and distinct from the other seller databases in the plurality of seller databases;

a selection of a product class received from one of the plurality of buyers; and

**in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class.** (Emphasis Added).

Amended independent claims 11 and 20 recite similar limitations. *Khan* or the Examiner's Official Notice either individually or in combination, fail to disclose each and every limitation of independent claims 1, 11, and 20.

The Applicants respectfully submit that *Khan* has nothing to do with amended independent claim 1 limitations regarding an “**electronic commerce system for facilitating an electronic commerce transaction**” and in particular *Khan* has nothing to do with amended independent claim 1 limitations regarding “**a global content directory for providing a plurality of buyers access to a distributed plurality of seller databases**, each seller database associated with a corresponding seller and **distinct from other seller databases in the distributed plurality of seller databases**”. Rather *Khan* discloses a system for programming an internet browser bookmark for delivering information to a user. (Abstract). The internet browser bookmark in *Khan* is merely a list of browser favorites saved as links to connect the user with various saved websites. In addition, the user in *Khan* is not a buyer or even an interested party in purchasing or even potentially purchasing, anything from a distributed plurality of seller databases, instead the user in *Khan* is merely a passive, non-transactional individual seeking only content delivery from these linked websites. Thus, *Khan* cannot provide an “**electronic commerce system for facilitating an electronic commerce transaction**” or even “a

**global content directory for providing a plurality of buyers access to a distributed plurality of seller databases**, each seller database associated with a corresponding seller and **distinct from other seller databases in the distributed plurality of seller databases**", since *Khan* does not teach, suggest, or even hint at anything more than a passive non-transactional user seeking content from linked websites that are not connected to or associated with a distributed seller database or any other type of distributed database.

In addition, it appears that the Examiner is equating the "**electronic commerce system for facilitating an electronic commerce transaction**" recited in amended independent claim 1 with the "**buy now**" notification frame disclosed in *Khan*. (23 March 2006 Office Action, Page 16). (Emphasis Added). However, the "**buy now**" notification frame disclosed in *Khan* is merely provided as a notification that a good that a user ordered is in stock. (Column 15, Lines 11-16). In contrast, the "**electronic commerce system for facilitating an electronic commerce transaction**" recited in amended independent claim 1 is provided for enabling electronic commerce ("e-commerce") transactions between buyers and sellers through the use of a global content directory supported by a global content directory server. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Khan* and amended independent claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Khan*.

The Applicants further submit that *Khan* has nothing to do with amended independent claim 1 limitations regarding "one or more pointers associated with each product class in the plurality of product classes, **each pointer identifying the seller database in the distributed plurality of seller databases in which product data enabling a product transaction is stored for products associated with the product class, the seller database identified by the pointer being associated with its corresponding seller and being distinct from the other seller databases in the distributed plurality of seller databases**". Although *Khan* may disclose a plurality of bookmarks (Figure 10), *Khan* does not disclose a pointer identifying a single bookmark, a

plurality of bookmarks, or even a bookmark associated with its corresponding seller distinct from the other bookmarks in the plurality of bookmarks. It appears that the Examiner is purporting to establish that the bookmarks in *Khan* are some how related to the one or more pointers in the subject Application. However, it is not clear how the bookmarks in *Khan* are purportedly based or analogous to the one or more pointers associated with each product class in the subject application. ***Even assuming for the sake of argument that the bookmarks in Khan are somehow analogous to the one or more pointers associated with each product class in the subject application, which they are not, in fact they are clearly not***, there is still no disclosure, teaching, or suggestion in *Khan* that there are “one or more pointers associated with each product class in the plurality of product classes, ***each pointer identifying the seller database in the distributed plurality of seller databases in which product data enabling a product transaction is stored for products associated with the product class, the seller database identified by the pointer being associated with its corresponding seller and being distinct from the other seller databases in the distributed plurality of seller databases***”.

In particular, the Examiner equates the “***one or more pointers associated with each product class***” recited in amended independent claim 1 with “a product SPECIAL FARE” allegedly disclosed in *Khan*. (23 March 2006 Office Action, Page 7). However, *Khan* does not disclose, suggest, or even hint at a pointer associated with a product class or even “a product SPECIAL FARE” as alleged by the Examiner. In contrast, the “***one or more pointers associated with each product class***” recited in amended independent claim 1 is provided for “***identifying the seller database in the distributed plurality of seller databases in which product data enabling a product transaction is stored for products associated with the product class***” and in addition “***the seller database identified by the pointer being associated with its corresponding seller and being distinct from the other seller databases in the distributed plurality of seller databases***”. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Khan* and amended independent claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Khan*.

The Applicants still further submit that the previous Office Action acknowledged, and the Applicants continue to agree, that *Khan* fails to disclose the emphasized limitations noted above in amended independent claim 1. Specifically ***the Examiner acknowledged that Khan fails to disclose the use of a search interface operable to communicate a search query for product data to one or more seller databases identified by the one or more pointers associated with the selected product class.*** (30 September 2005 Final Office Action, Page 3). (Emphasis Added). However, in the previous Office Action, the Examiner asserted that the cited portions of *Suzuki* disclose the acknowledged shortcomings in *Khan*. However, in the present Office Action, the Examiner has withdrawn the obvious rejection with respect to *Suzuki* and instead relied on *Khan*. The Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Khan* and amended independent claim 1 cannot be made.

The Applicants respectfully submit that *Khan* has nothing to do with amended independent claim 1 limitations regarding a ***“search interface operable to communicate a search query for product data to the one or more seller databases identified by the one or more pointers associated with the selected product class,*** each seller database associated with its corresponding seller and distinct from the other seller databases in the plurality of seller databases”. In particular, the Examiner equates the ***“search interface operable to communicate a search query for product data”*** recited in amended independent claim 1 with “query[ing]” a user disclosed in *Khan*. (23 March 2006 Office Action, Page 7). However, the “query[ing]” of a user disclosed in *Khan* merely asks a user for a time to remind the user to visit the website and is only provided for a website with a bookmark having the alarm feature selected. (Column 11, Lines 22-34). In contrast, the ***“search interface operable to communicate a search query for product data”*** recited in amended independent claim 1 is provided for ***“communicat[ing] a search query for product data to the one or more seller databases”*** and where the ***“one or more seller databases”*** is ***“identified by the one or more pointers associated with the selected product class”***.

In addition, there is simply no disclosure, teaching, or suggestion of **“a plurality of seller databases”**, let alone communicating **“a search interface operable to communicate a search query for product data to the one or more seller databases identified by the one or more pointers associated with the selected product class,”** as recited in amended independent claim 1. The mere fact that *Khan* may disclose a query that allows a user to provide a time to be reminded to visit the website, is in no way related to **“a plurality of seller databases”**, let alone communicating **“a search interface operable to communicate a search query for product data to the one or more seller databases identified by the one or more pointers associated with the selected product class,”** as recited in amended independent claim 1. Thus, *Khan* cannot provide **“a search interface operable to communicate a search query for product data to the one or more seller databases identified by the one or more pointers associated with the selected product class,”** since *Khan* does not even provide for a search interface, receiving a selection of a product class by a user of the global content directory, or even communicating a search query for product data to seller databases identified by pointers associated with the selected product class.

The Applicants further respectfully submit that *Khan* has nothing to do with amended independent claim 1 limitations regarding “a selection of a product class received from one of the plurality of buyers” and **“in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class.”** In particular, the Examiner equates the **“search query for product data”** recited in amended independent claim 1 with a query to a user disclosed in *Khan*. (23 March 2006 Office Action, Page 8). However, the query of a user disclosed in *Khan* **merely asks a user whether the user would like to be notified of updates from the website** and is only provided to a user who has selected that particular interval in operation. (Column 11, Line 50 through Column 12, Line 5). In contrast, the **“search query for product data”** recited in amended independent claim 1 is provided for **“communicating a search query for product data to one or more seller databases”** and which are **“identified by one or more pointers associated with the selected product class”**. Thus, the



Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Khan* and amended independent claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Khan*.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Khan* and the Examiner's Official Notice, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been well within the level of one of ordinary skill in the art at the time the invention was made to combine *Khan* with knowledge of one of ordinary skill to disclose that each seller database is associated with its corresponding seller and distinct from the other seller databases in the plurality of seller databases **for the obvious reason that different sellers may specialize in particular industries and particular products.**" (23 March 2006 Office Action, Page 9). (Emphasis Added). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Khan* or the Examiner's Official Notice, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be because "**different sellers may specialize in particular industries and particular products.**" (23 March 2006 Office Action, Page 9). (Emphasis Added). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. For example, how does the reason that "**different sellers may specialize in particular industries and particular products**" relate to each seller database is associated with its corresponding seller and distinct from the other seller databases in the plurality of seller databases and to what extent does the Examiner purport that the reason that "**different sellers may specialize in particular industries and particular products**" applies to the subject Application. **The Applicants respectfully request the Examiner to point to the**

*portions of Khan or the Examiner's Official Notice which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner's stated purported advantage.* In particular, the Applicants respectfully request the Examiner to point to the portions of *Khan* or the Examiner's Official Notice which expressly state that the reason that "***different sellers may specialize in particular industries and particular products***" accounts for each seller database is associated with its corresponding seller and distinct from the other seller databases in the plurality of seller databases. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, ***the Examiner has not adequately supported the selection and combination of Khan and the Examiner's Official Notice to render obvious the Applicants claimed invention.*** The Examiner's conclusory statements that "it would have been well within the level of one of ordinary skill in the art at the time the invention was made to combine *Khan* with knowledge of one of ordinary skill to disclose that each seller database is associated with its corresponding seller and distinct from the other seller databases in the plurality of seller databases ***for the obvious reason that different sellers may specialize in particular industries and particular products***", ***does not adequately address the issue of motivation to combine.*** (23 March 2006 Office Action, Page 9). (Emphasis Added). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office***

***Action fails to provide proper motivation for combining the teachings of Khan or the Examiner's Official Notice, either individually or in combination.***

**The Proposed *Khan*-Official-Notice Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

The Applicants respectfully submit that *Khan* or the Examiner's purported Official Notice, either individually or in combination, fails to disclose, teach, or suggest each and every element of amended independent claims 1, 11, and 20. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of amended independent claims 1, 11, and 20 under 35 U.S.C. § 103(a) over the proposed combination of *Khan* and the Examiner's Official Notice, either individually or in combination.

The Applicants further submit that the Applicants are confused as to what the Examiner is intending to teach by the Official Notice or even the extent in which the Examiner is taking Official Notice. ***The Applicants respectfully request clarification as to the subject matter for which the Examiner is taking Official Notice. The Applicants respectfully traverse the Official Notice because the asserted facts, as best understood by the Applicants, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight.*** Furthermore, under these circumstances, ***it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion.*** (See MPEP § 2144.03). ***The Applicants respectfully request the Examiner to produce authority for the Examiner's purported Official Notice.***

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence ***should only be taken by the examiner*** where the facts asserted to be well-known, or to be common knowledge in the art are ***capable of instant and unquestionable demonstration as being well-known.*** With respect to the subject Application, ***the Examiner's statement***

that “Official Notice is taken that different sellers sell different products and services”, ***is not capable of instant and unquestionable demonstration as being well-known or even related to the subject Application.*** (23 March 2006 Office Action, Page 9). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘***capable of such instant and unquestionable demonstration as to defy the dispute***’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)).” (MPEP § 2144.03(A)). (Emphasis Added).

***“It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.*** *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. (Emphasis Added). As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).” (MPEP § 2144.03(A)). “Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that ***general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection***). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

With respect to the subject Application, ***the Examiner has not properly Officially Noticed or not properly based the Official Notice on common knowledge.*** The Examiner's conclusory statement:

Official Notice is taken that **different sellers sell different products and services**. For example, TRAVELOCITY often specializes in travel, DELTA AIRLINES specializes in airline seats, AVIS CAR RENTAL rents cars, GAP often sells clothing, including cargo pants. (23 March 2006 Office Action, Page 9). (Emphasis Added).

The above noticed Examiner's conclusory statement **does not adequately address the issue that this statement is considered to be common knowledge, well-known in the art, or even related to the subject Application**. The Applicants respectfully submit the following statement, to further explain why the Examiner's above noticed statement is not considered to be common knowledge or well-known in the art.

**First**, it is not clear what the Examiner means by "**different sellers sell different products**" (i.e. what "**different sellers**" is the Examiner referring to and to what extent does the Examiner purport "**selling different products**" applies to the subject Application). In fact, the limitations recited in amended independent claim 1 are directed to "**a global content directory for providing a plurality of buyers access to a distributed plurality of seller databases**" which are "associated with a corresponding seller and **distinct from other seller databases in the distributed plurality of seller databases**". It is not clear how the Examiner's Official Notice that "**different sellers sell different products**" relates to the "**distributed plurality of seller databases**" or how it relates to "**providing a plurality of buyers access to a distributed plurality of seller databases**" or even how it is "**distinct from other seller databases in the distributed plurality of seller databases**".

**Second**, it is not clear what the Examiner means by "TRAVELOCITY often specializes in travel, DELTA AIRLINES specializes in airline seats, AVIS CAR RENTAL rents cars, GAP often sells clothing, including cargo pants" (i.e. what does "**specializes**" or what does "**often specializes**" referring to and how is specializing or even often specializing related to the subject application). In fact, the Examiner's assertions that "TRAVELOCITY often specializes in travel, DELTA AIRLINES specializes in airline seats, AVIS CAR RENTAL rents cars, GAP often sells clothing, including cargo pants" has nothing to do with "**a global content directory for providing a plurality of buyers**

**access to a distributed plurality of seller databases**, each seller database associated with a corresponding seller and **distinct from other seller databases in the distributed plurality of seller databases**", as recited in amended independent claim 1.

**Third**, as explained above, the Examiner's statement that "**different sellers sell different products**" is not considered to be common knowledge or well-known in the art or even related to the subject Application. The Applicants respectfully submit that the "**global content directory**" recited in amended independent claim 1 is for "**providing a plurality of buyers access to a distributed plurality of seller databases**" and each seller database is associated with a corresponding seller and each seller database is "**distinct from other seller databases in the distributed plurality of seller databases**". Thus, the Applicants further submit that the equations forming the foundation of the Examiner's comparison between the Examiner's Official Notice and amended independent claim 1 cannot be made.

**Fourth**, there is simply no disclosure, teaching, or suggestion in *Khan* or the Examiner's Official Notice of "**a global content directory for providing a plurality of buyers access to a distributed plurality of seller databases**" which are "associated with a corresponding seller and **distinct from other seller databases in the distributed plurality of seller databases**".

The Applicants respectfully submit that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted fact "that **different sellers sell different products and services**", is not capable of "instant and unquestionable" demonstration as being well-known. **The Applicants respectfully request the Examiner to produce authority for the Examiner's statement** "that **different sellers sell different products and services**", is old and well known and that this relates to the subject Application.

The Applicants further submit that **the Applicants have adequately traversed the Examiner's assertion of Official Notice** and direct the Examiner's attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of amended independent claims 1, 11, and 20 based on the Examiner's Official Notice, ***the Applicants respectfully request that the Examiner provide documentary evidence*** as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, ***the Applicants further request that the Examiner provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding*** as further necessitated by MPEP § 2144.03(C).

**The Proposed *Khan-Notani* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 2, 12, and 21.**

The Applicants respectfully submit that *Khan* or *Notani*, either individually or in combination, fails to disclose, teach, or suggest each and every element of dependent claims 2, 12, and 21. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of dependent claims 2, 12, and 21 under 35 U.S.C. § 103(a) over the proposed combination of *Khan* and *Notani*, either individually or in combination.

For example, with respect to dependent claim 2, this claim recites:

2. The electronic commerce system of Claim 1, wherein ***the directory structure comprises a lightweight directory access protocol (LDAP) directory***. (Emphasis Added).

Dependent claims 12 and 21 recite similar limitations. *Khan* or *Notani*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 2, 12, and 21.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Khan* fails to disclose the emphasized limitations noted above in dependent claim 2. Specifically, ***the Examiner acknowledges that Khan fails to disclose the directory structure comprises a lightweight directory access protocol (LDAP) directory.*** (23 March 2006 Office Action, Page 14). However, the Examiner asserts that the cited portions of *Notani* disclose the acknowledged shortcomings in *Khan*. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Notani*.

The Applicants respectfully submit that the subject Application and the *Notani* U.S. Patent Application Publication were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same entity, i2 Technologies US, Inc. In accordance with 35 U.S.C. § 103(c) and MPEP 706.02(I)(1), *Notani* is disqualified as prior art, in the subject Application. Thus, the Applicants respectfully submit that claims 2, 12, and 21 are in condition for allowance.

As mentioned above, the rejection under 35 U.S.C. §103(a) is moot in view of *Notani* being rejected as prior art. Thus, for at least the reasons set forth herein, the Applicants submit that claims 2, 12, and 21 are not anticipated by *Notani*. The Applicants further submit that claims 2, 12, and 21 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 2, 12, and 21 under 35 U.S.C. § 103(a) be reconsidered and that claims 2, 12, and 21 be allowed.

**The Applicants Claims are Patentable over the Proposed *Khan-Notani*-Official-Notice Combination.**

The Applicants respectfully submit that amended independent claims 11 and 20 include limitations similar to those discussed above in connection with amended independent claim 1. Thus, amended independent claims 11 and 20 are considered



patentably distinguishable over *Khan*, *Notani*, or the Examiners Official Notice for at least the reasons discussed above in connection with amended independent claim 1. With respect to dependent claims 2-10, 12-19, and 21-28: claims 2-10 depend from amended independent claim 1; claims 12-19 depend from amended independent claim 11; and claims 21-28 depend from amended independent claim 20. As mentioned above, each of amended independent claims 1, 11, and 20 are considered patentably distinguishable over the proposed combination of *Khan*, *Notani*, and the Examiner's Official Notice. Thus, dependent claims 2-10, 12-19, and 21-28 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants submit that claims 1-28 are not rendered obvious by the proposed combination of *Khan*, *Notani*, or the Examiner's Official Notice. The Applicants further submit that claims 1-28 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 1-28 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-28 be allowed.

#### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there ***must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and ***not based on applicant's disclosure***. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

6/7/06  
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